

- 11 -

Remarks

In the Final Office action mailed January 27, 2010, pending claims 47-51, 53, 54, 56-58, 60, 62-64, 66, and 68 are rejected, as stated in paragraph 1 of the Office action. In paragraphs 2-9 of the Office action there is a discussion of the scope of the claimed invention and the scope of the prior art in view of Applicants' prior response. This amendment is an attempt to clarify issues raised in the Office Action.

In paragraph 3 of the Office Action, the Examiner has correctly stated that a person of ordinary skill in the art would need to understand the meaning of the term "rules" in view of the specification. Applicants are submitting the Declaration of Professor Czerwinski (his CV attached) to establish that the meaning of "rules" is understood by a person skilled in the art. The Examiner incorrectly states that the term rules must be accompanied by the type of relationship attached to the type of rule in the claim. Applicants respectfully point out that claim limitations are the perogative of the Applicants, limited by the prior art and the requisites of patentability. However, to provide some clarification, Applicants have added the phrase "with at least one of the rules being about the subject." Paragraph 3 does not pose a statutory rejection but indicates comments on Applicants' prior responses.

Paragraph 4 of the Office action relates to whether the MC&S reference has rules that have conflicts. Applicants offer the Declaration of Professor David Czerwinski to aver that the reference does not teach "rules" that can have a conflict, let alone a conflict in view of an assessment of the user.

Paragraphs 5, 6, and 8 of the Office action relate to scope of an argumentative example in the response as illustrative of the claimed invention and are stated to be moot in view of new grounds of rejection. In mooting an argument in view of new grounds of rejection, it is understood that their former basis of rejection is withdrawn in favor of a new basis of rejection. In such a circumstance, the appropriateness of a final rejection is questioned. Usually a new basis for rejection is applied in a final rejection only where an amendment by Applicants has necessitated a change in the basis for rejection. See MPEP 706.07(a) which states that a final rejection is premature where there is a new ground of rejection that is neither necessitated by Applicants' amendment of the claims, nor based on information submitted in an information disclosure statement. Accordingly, Applicants assert a premature final rejection pursuant to MPEP 706.07(c). Though Applicants are entitled to a

- 12 -

withdrawal of the final rejection, Applicants have not done so. Instead, to expedite prosecution, Applicants have respectfully submitted a RCE.

Paragraph 7 alleged that MC&S taught internet and intranet because a school computer network is well known to have a private management system for faculty and a public system for student to receive lectures. Particularly in 1993, the copyright date of MC&S, Applicants suspect that faculty typically kept their system private via passwords. In any event, Applicants submit that MC&S has not taught or suggested Applicants' claimed network limitations of a private and a public network.

Paragraph 9 alleged that exhausting all tries in Table 2 of MC&S also led to the elapse of an allotted time to learn. It is unclear how one can draw such a conclusion. For example, a teacher has allotted 3 months for a student to learn multiplication. The student turns out to be very weak in the subject. Within a month, all the options in Table 2 have been exhausted, and there is still 2 months left to learn. Thus, exhausting all tries in Table 2 does not equate to the elapse of an allotted time to learn. MC&S does not teach or suggest additional materials to be presented to the user being determined depending on a time elapsed from when certain materials have been presented to the user, let alone materials being able to be repeated, with such materials no longer selected if the time elapsed is more than a predetermined duration of time, as in Applicants' claim 51.

In paragraph 10 of the Office action there was an objection to the drawings inasmuch as the drawings do not show every feature of the invention specified in the claims. A new drawing figure was requested by the Examiner and is added herein as Fig. 9. This figure is substantially similar to Fig. 8. The overall figure is shown with reference to a computer having a basis in the title of the invention and in the second word of the abstract, as well as in numerous places in the specification, including paragraph [0008] and elsewhere. Also, a computer typically includes storage, and the specification teaches storage at numerous places, such as in paragraphs [0014] and [0035].

Rules are defined, for example, in paragraph [0015] and in paragraph [0016]. Conflict existence among rules is resolved as described in, for example, paragraph [0017.06], where reference is made to adding a "new rule" to resolve a conflict among rules. One stated objective, for example, according to paragraph [0017] is in "assessment of the user's understanding of the subject". No new matter is added in Fig. 9 and the accompanying amendments of the specification.

- 13 -

The Examiner indicated that "resolving a conflict" must be shown, if claimed. The foundation for this feature is discussed in the specification and is shown, for example, as a middle block in the new drawing and was previously in Fig. 8.

Paragraphs 11 and 12 of the Office action relate to a rejection of claims 47, 57, and 63 under 35 USC § 112, first paragraph. In particular, the Office action states that the phrase "resolving the conflict by generating another rule" is not supported by the specification and is therefore considered new matter. Applicants respectfully point out that, for example, paragraphs [0017.01] through [0017.06] deal with conflicts among rules and the adding of a new rule. These paragraphs were previously added to the present specification by amendment as text that was in prior applications, incorporated by reference herein. The paragraphs may be found in parent application S.N. 09/255,042, now U.S. Pat. Nos. 6,118,973 (column 8, lines 44 to column 9, lines 34) and 5,779,486, where the text is found almost verbatim. The entire specification of 5,779,486 has previously been incorporated by reference. The text involving "resolving the conflict by generating another rule" is clearly supported. 37 C.F.R. 1.57(b) allows incorporation by reference of essential material. Applicants are asserting the benefit of rule 1.57(b) in order to support the text quoted above.

As a side note, Applicants would like to identify supports for a number of paragraphs added to the specification. Regarding paragraphs [0064.01] to [0064.12], support for these paragraphs may be found, for example, in parent application S/N 08/675,391, now U.S. Pat. No. 5,863,208, as shown in the following:

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|------------------------|--------------------------------------|
| [0064.01] to [0064.02] | Col. 5, lines 31-51; |
| [0064.03] | Col. 7, lines 12-14; |
| [0064.04] | Col. 7, lines 31-36; and |
| [0064.05] to [0064.12] | Col. 9, line 10 to col. 10, line 20. |

Accordingly, no new matter has been introduced.

Returning to the Office Action, its paragraphs 13 - 15 pertain to a rejection of claims 47-51, 53-54, 56-58, 60, 62-64, 66, and 68 under 35 USC § 112, second paragraph. In particular, the Office action states that independent claims 47, 57, and 63 mention "at least two rules" without a descriptive meaning of what they are, thus making the claims indefinite. To expedite prosecution, Applicants have amended claims 47, 57, and 63 to set forth that at least one of the two rules is about the subject. Support for this text may be found in the specification, for example, in paragraph [0017.01] relating to rules associated with specific

- 14 -

areas, namely algebra, geometry, and trigonometry. The Examiner states that it is unclear as to what and how the at least two rules "having a conflict in view of an assessment of the user". Reference is made to paragraph [17.03] of the specification where an example is given. Claims must be read in light of the specification. The conflict among rules is clearly explained in the specification, for example, wherein sometimes a student can be good in trigonometry, but weak in algebra. But an assessment of the student can give rise to a conflict in a rule that indicates otherwise, and the conflict must be resolved. The text in paragraphs [0017.01] through [0017.05] present examples that clearly demonstrate the concept that was stated to be unclear.

Paragraphs 16-25 contain a rejection of the claims under 35 USC § 103, relying on the MC&S reference. At the bottom of page 7 of the Office action the Examiner states "MC&S fails to disclose a conflict upon the rules that governed the selection of the next material of study because computer algorithms cannot encounter conflicting parameters; there is always a second set of rules (of higher priorities), to follow if the program encounters an impasse. 'If then else' statements always have a way out and conflicting data always has another direction to take as is in the Applicants' disclosure". The Examiner's statement may be true for a simple and fixed set of rules, particularly when there is no external influence. In such a situation, passing one item of a subject leads to a fixed next item. Indeed, this is the characterization of the MC&S system by the Declaration of Professor Czerwinski, where items are presented in a linear fashion. On the other hand, the present invention claims more complex situations where there can be external influence – an assessment of the user as an input that can change the progression of the rules. In Applicants' claimed invention, the rules do not exist in a vacuum, but can be impacted by an assessment and then a new rule is generated in view of a consequence of at least one rule differing from the assessment. And the new rule helps determine additional materials to present to the user. The claimed procedure is different from MC&S which does not have conflicts among its rules nor the generation of a new rule when the assessment of the user is at variance with a consequence of at least a rule. The Examiner's admission that "MC&S fails to disclose a conflict" is correct and should be considered as evidence of non-obviousness. Also, the Examiner is respectfully reminded that the rules are used by a computing device. Teaching priorities of a human teacher can be different from those of a computing device. It is inappropriate for the Examiner to base its rejection entirely on proceeding from a human perspective, while

- 15 -

ignoring the computing device perspective.

The lack of rules in conflicts in MC&S is attested by the attached declaration under Rule 132 by Professor David Czerwinski, a professor in the College of Business of San Jose State University. In a situation where an Examiner asserts *prima facie* obviousness, Applicants are entitled to submit external evidence of non-obviousness, such as the enclosed expert declaration. Professor Czerwinski has the opinion that there is no conflict resolution among rules in the MC&S reference because the MC&S system goes from one item to the next in a linear fashion, when passing one item always leads to a fixed next item. On the other hand, as attested in Professor Czerwinski's declaration, Applicants' claimed invention involving use of rules and resolution of conflicts among rules is a different approach. Professor Czerwinski avers that the MC&S reference is on presenting materials in a linear fashion, whereas the Applicants claim a more complex approach. Presenting materials in a linear fashion, as described by Professor Czerwinski, occurs when passing through one item always leads to a fixed next item, as in MC&S Figure 1. Conflicts do not arise in such a simple system. Taking this into account, Professor Czerwinski concludes that Applicants' claimed system is not obvious in view of the MC&S approach.

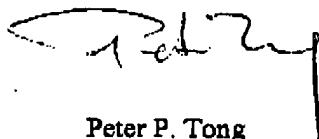
Objective evidence of non-obviousness must be considered in deciding obviousness.

- 16 -

Conclusion

Applicants request Reconsideration and a Notice of Allowance.

Respectfully submitted,



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